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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,875	09/25/2000	Jerry Freestone	NTL-3.2.133/3405 (12052SC	3055

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EXAMINER	
WON, MICHAEL YOUNG	

ART UNIT	PAPER NUMBER
2155	

MAIL DATE	DELIVERY MODE
01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/668,875	**Applicant(s)** FREESTONE ET AL.	
	Examiner Michael Y. Won	**Art Unit** 2155	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-45*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached Document.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Bharat Barot.

BHARAT BAROT
PRIMARY EXAMINER

Response to Arguments

Applicant(s) argue that Logan does not teach the features defined by claim 1. Claim 1 has been reproduce below:

Claim 1. An electronic message configured to be communicated between a sender's device and a recipient's device, the electronic message comprising:

a sound file attached to the electronic message; and

a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with said sound file.

The applicant(s) seem to assert that because the citations are in different locations that somehow Logan is referring to different messages rather than a **single** electronic message. In response to applicant's arguments, it is noted that the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore regardless of whether Logan teaches a single message or many messages, the limitation reads, "a sound file attached to the electronic message" which is clearly and explicitly taught by the citation "the comment could be transmitted as an audio file attachment to an E-mail message" (see col.42, line 67-col.43, line 2).

The applicant(s) argue that a "program_id is not transmitted with the e-mail or even mention the possibility of attaching other files to the e-mail". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that these features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). No where in the body of the claim is there any suggestion that a predetermined identifier is **transmitted** with the e-mail, much less attaching other files to the e-mail". The applicant(s) seem to be gleaning elements and limitations from the specification into the claims.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. See In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Furthermore, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is **not** the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. See In re American Academy of Science Tech Center, F.3d 2004 WL 1067528 (Fed. Cir. May 13, 2004).

Because Logan teaches that an audio file can be attached to an email (see above) and because Logan teaches that audio files include identifiers (see col.16, lines 51-57; col.17, lines 47-61; and col.18, lines 22-27), it is inherent that when an audio file is attached to an e-mail message, the corresponding ID is also attached. The remaining

citations in the office action clearly and explicitly teach wherein the identifier "distinguishes said sound file from other files" ("identify and differentiate the different program segments") and "indicates a course of action to be taken by the recipient's device" ("order in which the downloaded program segments are to be played").

For the reason above the pending claims remain rejected. For the sake of expediting prosecution, the applicant(s) are suggested to clearly and explicitly recite the functional limitations that make the claimed invention novel. A message containing a sound file and an identifier is neither novel nor the inventive functional aspect of this claimed invention. Although Logan teaches these limitations, relying on these broad limitations merely prolongs the prosecution process.